Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG P. NADEL AND DIETMAR NAGEL

Appeal No. 1998-2028
Application No. 08/365584

ON BRIEF

Before ABRAMS, McQUADE, and LAZARUS, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 4-12, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a figurine having illuminatable and nonilluminatable fibers. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Katzman et al. (Katzman)	4,626,225	Dec. 2, 1986
Cocca	4,998,186	Mar. 5, 1991
Osborne et al. (Osborne)	5,277,644	Jan. 11, 1994
Konta et al. (Konta)	5,288,259	Feb. 22, 1994

The following rejections stand under 35 U.S.C. § 103:[1]

(1) Claims 1, 4, 6-8, 10 and 12 on the basis of Konta and Cocca.

(2) Claims 5 and 11 on the basis of Konta, Cocca and Katzman.

(3) Claim 9 on the basis of Konta, Cocca and Osborne.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 16) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 19) for the appellants' arguments thereagainst.

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[1]A rejection of claims 1 and 4-12 under 35 U.S.C. § 112, second paragraph, as being indefinite, was overcome by an amendment filed after the final rejection (see Papers no. 8 and 10).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, the applied prior art references, the respective positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The appellants' invention is directed to providing a figurine with a bunch of fibers as hair, for example, which bunch comprises a plurality of nonilluminatable fibers and a plurality of illuminatable fibers. As manifested in claim 1, the illuminatable fibers are optical fibers and each one is disposed closely proximate a plurality of nonilluminatable fibers and is of lesser length than the surrounding nonilluminatable fibers.

It is the examiner's view that Konta discloses all of the subject matter of claim 1 except for the illuminatable fibers being of a shorter length than the nonilluminatable fibers, but that Cocca teaches making illuminatable fibers of different lengths, and therefore it would have been obvious to one of ordinary skill in the art to modify the hair of Konta in accordance with the requirements of claim 1 because the length of hair on a doll is a design choice (Answer, pages 5 and 6). The appellants argue that the only suggestion for doing so is hindsight. We agree.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

While Konta discloses hair comprising illuminatable and nonilluminatable fibers, the reference is silent as to there being any difference in the lengths of each type of fiber, much less that the illuminatable fibers be of shorter length than the nonilluminatable ones. Cocca discloses a decorative hair ornament having a plurality of illuminatable fibers of differing lengths. However, there are no nonilluminatable fibers in the Cocca ornament. From our perspective, therefore, one of ordinary skill in the art would not have found suggestion in either of these references to modify the Konta hair by making the illuminatable fibers in the mixed bunches shorter than the nonilluminatable ones. The only suggestion for this is

found, as the appellants opined, in the luxury of the hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

A prima facie case of obviousness therefore has not been established with regard to the subject matter of independent claim 1. This being the case, the rejection of claim 1 is not sustained nor, it follows, is the like rejection of claims 4, 6-8, 10 and 12, which depend therefrom.

The teachings of Katzman and Osborne, cited against others of the dependent claims, fail to alleviate the above-stated deficiency in Konta and Cocca. The rejections of claims 5, 9 and 11 also are not sustained.

CONCLUSION

None of the rejections are sustained.

The decision of the examiner is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)))))) BOARD OF PATENT
JOHN P. McQUADE Administrative Patent Judge	) APPEALS) AND) INTERFERENCES
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APJ LAZARUS

DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 30 Mar 01

FINAL TYPED: